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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/987,380	12/09/1997	MASAO INOUE	Q48500	6198
7590 01/28/2008 SUGHRUE MION ZINN MACPEAK & SEAS 2100 PENNSYLVANIA AVENUE NW WASHINGTON, DC 200373202				
EXAMINER				
WANG, SHENGJUN				
ART UNIT		PAPER NUMBER		
1617				
MAIL DATE		DELIVERY MODE		
01/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING  
2  
3 UNITED STATES PATENT AND TRADEMARK OFFICE  
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5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
8

9  
10 Ex parte MASAO INOUE, MASAO OGAWA and  
11 HIROSHI NAKAMURA  
12

13  
14 Appeal 2007-3263  
15 Application 08/987,380  
16 Technology Center 1600  
17

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19 Oral Hearing Held: November 13, 2007  
20  
21

22  
23 Before ERIC B. GRIMES, LORA M. GREEN, and NANCY J. LINCK,  
24 *Administrative Patent Judges*.  
25

26  
27 ON BEHALF OF THE APPELLANTS:  
28

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36 The above-entitled matter came on for hearing on Tuesday,  
37 November 13, 2007, at The U.S. Patent and Trademark Office, 600 Dulany  
38 Street, Alexandria, Virginia, before Timothy J. Atkinson, Jr., Reporter.

1 MS. COOK: We have before us Calendar Number 22, Appeal  
2 Number 2007-3263, attorney John Callahann.

3 JUDGE GRIMES: Good Morning, Mr. Callahann.

4 MR. CALLAHANN: Good Morning.

5 JUDGE GRIMES: As you might know, you'll have 20 minutes  
6 to make your argument. So, please make yourself comfortable and get  
7 started whenever you're ready.

8 MR. CALLAHANN: Okay, great. Just quickly set up my file  
9 and I'll be ready to start.

10 JUDGE GRIMES: Okay, whenever you're ready.

11 MR. CALLAHANN: Okay. Good morning. My name is John  
12 Callahann and I'm here today in connection with the appeal for U.S.  
13 Application Serial Number 08/987380. And I believe that the Board needs  
14 to consider primarily three issues in connection with this appeal.

15 First, of course, the law applicable to the case has changed.  
16 This application went up on appeal in a pre-KSR error and we argued on our  
17 brief appropriately that there was no -- primarily that there was no  
18 motivation in the references to arrive at the claimed invention. In addition  
19 to, there is evidence of un-obviousness. The Appeal is now being  
20 considered in a post-KSR era, so we believe that there are differences, of  
21 course, between the law. The KSR case said that the TSM analysis was too  
22 rigid, but we believe that the outcome should be the same; that the  
23 Examiner's prima facie case of obviousness is improper.

24 The second issue that we believe the Board needs to consider is,  
25 I've mentioned it already, the fact that there is no prima facie obviousness  
26 case made by the Examiner. The Examiner, of course, has the burden to

1 make the prima facie obviousness case. We believe that he has not done that  
2 in this, in this prosecution of this application.

3 And, the third issue that the Board needs to consider is the fact  
4 that we have presented evidence of un-obviousness; that the Examiner, I  
5 believe, is improperly criticized. We do not admit that the Examiner has  
6 made a prima facie obviousness rejection, but we believe in any event that's  
7 been overcome by the declaration that we've submitted during the  
8 prosecution. So, I believe that those are primarily the three issues that the  
9 Board needs to consider. So, let me go back to each of them in turn.

10 First of all with regard to the law of obviousness, we argue the  
11 Appeal based upon there being a lack of motivation in the three references  
12 that the Examiner cited. The primary reference is a reference by the name of  
13 Tocker, T O C K E R, and the secondary references are Burger and Kogler,  
14 K O G L E R. The claimed invention relates to a pesticide that's coated with  
15 a polyurethane. The claims are a little bit -- are set up in a way that they  
16 cover two different embodiments. We elected the embodiment that relates  
17 to polyurethane. I believe the other embodiment relates to an epoxy coating.  
18 But the invention relates to a pesticide that is coated with a polyurethane  
19 where the isocyanate and the polyol components of the polyurethane are  
20 applied to the pesticide together. Claim 1 is a composition, it refers to Claim  
21 6, which is the method that requires that step. And of course there's other  
22 elements of the claim, but that's essentially for purposes of this Appeal what  
23 I think should be focused upon.

24 The primary reference that the Examiner used to reject the  
25 claims is a reference by the name of Tocker, T O C K E R, and that  
26 reference relates to so called interfacial polymerization. And what that

1 means in the context of this technology is, generally speaking, interfacial  
2 polymerization is a low temperature polymerization technique whereby  
3 polymerization of two reactants is carried out at the interface between two  
4 phases; each containing one of the reactants. Technically speaking the  
5 reactants diffuse to and undergo polymerization at the interface, and I'm  
6 referring in that sense to the definition from Odian, which is principles of  
7 polymerization. I don't believe that this is of record, but this is a well  
8 known text book in the field of polymerization. But specifically what  
9 Tocker teaches is including the polyol component of the polyurethane with  
10 the pesticide and then adding the isocyanate. So, in a sense it's this  
11 interfacial polymerization which is different from what were claiming in our  
12 application. The Examiner recognizes that, and he relies on two secondary  
13 references to teach or to show that the claimed invention would have been  
14 obvious, but we would submit to the Board that that would not be  
15 appropriate. The rejection would, in essence, destroy the teachings of the  
16 primary reference.

17           The primary reference, Tocker, clearly states that its invention  
18 relates to this interfacial polymerization, and I'm referring to Page 2 of the  
19 Tocker reference at lines approximately 26. But, it states that the invention  
20 relates to a process for preparing controlled release granules of pesticides for  
21 direct application consisting essentially of over coating a granular carrier  
22 containing a pesticide and a polyhydroxylated compound, which would be  
23 the polyol or water with a liquid polyisocyanate and a polymerization  
24 catalyst optionally at elevated temperatures resulting in interfacial  
25 polymerization to a solid cross-linked polyurethane or polyurene barrier. So  
26 the primary reference is clear about the specific polymerization technique

1 that it's using. So in our view it would be, in essence, destroying the, the  
2 essential teachings of the primary reference to make the substitution that the  
3 Examiner is suggesting. He's suggesting that you, in essence, eviscerate the  
4 whole teaching of the primary reference and substitute teachings of the  
5 secondary references which show that the two components of the  
6 polyurethane can be added at the same time.

7 JUDGE GRIMES: But if the point of both sets of references is  
8 to coat something with polyurethane, then I'm having a hard time seeing  
9 what the big difference would be if in both cases you end up with  
10 polyurethane coat on a granule of something.

11 MR. CALLAHANN: Well in the invention we coat the  
12 pesticide or we add the pesticide -- we add to the pesticide, excuse me, the  
13 two components of the polyurethane. The rejection is set up in such a way  
14 that the primary reference teaches this interfacial polymerization where you  
15 have the pesticide with one component with polyurethane and then you add  
16 the second component with polyurethane. So, I see what you're saying, but  
17 in terms of the analysis of obviousness in the case, you have to start with the  
18 primary reference and what the primary reference teaches. And, then  
19 determine whether it would have been obvious to a person with ordinary  
20 skill in the art to modify the primary reference in view of the teachings of  
21 the secondary reference. So if that's the way -- or else we're comparing the  
22 claimed invention to the claimed invention in a sense that the claimed  
23 invention requires adding the two components of the polyurethane to the  
24 pesticide and I believe you're saying, well, look at the references as a whole;  
25 they do teach generally the same thing. But I, I think the obviousness  
26 analysis should be a little bit sharper and more focused on the primary

1 reference and whether or not it would have been obvious to one skilled in  
2 the art to modify the primary reference in view of the secondary references.  
3 And we would submit that that's not the case because to do so would be to  
4 essentially destroy the core or essential element of the primary reference.

5 JUDGE GREEN: What if reversed the rejection. You either  
6 used Burger or Kogler as your primary reference because they teach a  
7 polyurethane coated agri-chemical that's in a granule and you relied on  
8 Tocker for teaching that you can get a pesticide as a granule that is coated  
9 with, coated with polyurethane. You think the same analysis would fit?

10 MR. CALLAHANN: Well, that is a different rejection.

11 JUDGE GREEN: I understand that, but I mean this is still the  
12 same set of references so I guess when, when you consider the references as  
13 a whole --

14 MR. CALLAHANN: Well, I don't want to sidestep your  
15 question, but the Appeal today is the rejection of Tocker in view of the two  
16 secondary references. I don't know why the Examiner didn't make the  
17 rejection that I think you're, you're, you're perhaps proposing. I don't  
18 know, that would be a different issue and a different analysis, you know.  
19 Obviousness is a mixture of law and fact. It's a legal conclusion based upon  
20 factual underpinnings. So I would have to study that combination very  
21 carefully and, and analyze whether it would have been an obvious to modify  
22 one or more of the secondary references in view of the primary reference,  
23 which I think is what you're proposing. But you have to start somewhere in  
24 terms of the obviousness analysis. Whether it's as in this appeal; the  
25 rejection of Tocker in view of Burger and Kogler or perhaps a different  
26 rejection such as Burger or Kogler in view of Tocker. But I haven't

1 analyzed that rejection because it wasn't up on appeal.

2 JUDGE LINCK: With respect to the other rejection that is  
3 before us, what specific claim language are you focusing on?

4 MR. CALLAHANN: Yes, yes. First of all, Claim 1 is the  
5 granular pesticidal composition that refers to when the embodiment is the  
6 polyurethane resin; Claim 6. Claim 6 is the method for manufacturing a  
7 granular pesticidal composition coated with a polyurethane resin comprising  
8 the steps of -- two steps; Step A is adding a mixture containing 0.05 to 1.5  
9 parts by weight of three alternatives: one, two and three. I'll just focus on  
10 the first one. Polyisocyanate having a tri or higher isocyanate groups and  
11 polyol. So it would be the step of adding a mixture containing between 0.05  
12 to 1.5 parts by weight of this isocyanate and polyol to the pesticidal active  
13 ingredient containing granule to be coated, and that's towards the bottom of  
14 Claim 6. And then B is repeating Step A. So, that step would be our  
15 position requires the addition of the isocyanate and the polyol together to the  
16 pesticide.

17 JUDGE LINCK: At the same time?

18 MR. CALLAHANN: That's right. So, I believe I covered the  
19 two points that -- the first two points that I believe the Board needs to  
20 consider the fact that the law has changed, but I think the outcome should  
21 still be the same. The second which is we believe that the Examiner has not  
22 made a prima facie obviousness rejection. Specifically, that he's not carried  
23 his burden to set forth a reasonable rationale as to why the claimed invention  
24 would have been obvious based upon the references he's relied upon.

25 The third issue that I believe the Board needs to consider is the  
26 evidence of nonobviousness that the Applicant submitted. As I've



1 mentioned, we don't agree that the Examiner has made a prima facie  
2 obviousness rejection. But in any event, we believe that the declaration that  
3 was submitted with, I believe, an RCE during the prosecution shows an  
4 unpredictable result for the claimed invention. Specifically a -- and a greatly  
5 extended controlled release of the pesticide as compared to the embodiment  
6 that is in -- that does correspond to the primary reference. And again, I think  
7 that that's the proper analysis because I think the Examiner got off track on  
8 that part of the prosecution too. We submitted the declaration. There was a  
9 comparison between the claimed invention and the closest prior art, which  
10 the Examiner has identified as the Tocker reference. So the claimed  
11 invention again would be the addition of the two components of the  
12 polyurethanes; the pesticide at the same time versus the addition of the  
13 isocyanate to the pesticide containing the polyol. That was the direct  
14 comparison in the declaration that was submitted and we were able to show  
15 that there is a greatly extended, I believe at least three times extended,  
16 controlled release of the pesticide. The Examiner didn't dispute that, but he  
17 criticized the declaration on the basis that it was not the correct comparison.  
18 In the Examiner's view the declaration should have compared the claimed  
19 invention to the combination of the references, but I would submit to the  
20 Board that that's not the proper analysis. I believe that that is clear from the  
21 case law and also the MPEP. Because that would be, in essence, comparing  
22 the claimed invention to the claimed invention. So again in terms of the  
23 obviousness analysis and also the analysis of the evidence of obviousness.  
24 You have to start somewhere, of course. And I believe that the Applicants  
25 correctly started with the primary reference; Tocker reference and compared  
26 the claimed invention to the Tocker reference and showed an unexpected

1 result. And that's --

2 JUDGE GREEN: I'm sorry. Would you agree that both of the  
3 secondary references, which I understand that you don't agree with the  
4 combination, that they discuss that you can change the amount of controlled  
5 release that you get depending on how much coating you put on the particle  
6 and specifically pointing to Figure 3 of Burger, and I have the Canadian one,  
7 it says on Line 3 that you can get a controlled release that is similar to your  
8 controlled release using their coating method?

9 MR. CALLAHANN: Again, it's, it's not that I disagree with  
10 the rejection, it's just that the Examiner hasn't made it. But, you're correct.  
11 There is data in the Canadian -- I'll call it the Canadian Patent -- Canadian  
12 reference, that would have to be considered if that type of rejection was  
13 made. So, I'd like to point out just one other point in connection with the  
14 declaration. That is in line with all the guidelines that the Patent Office has  
15 put forth. Nearly every guideline that the Patent Office had set out in  
16 connection with the KSR case relates to -- or refers to predictability or a  
17 predictable result. So the declaration shows, I would submit, an  
18 unpredictable result for the claimed invention. Now in summary, the  
19 Applicants would submit that there's no reason to modify Tocker as alleged  
20 by the Examiner. And the Examiner's rejection would eliminate the  
21 essential element of Tocker which is the interfacial polymerization and  
22 substitutes teachings from the secondary reference. So, it would not be  
23 obvious and not common sense to destroy the teachings of the primary  
24 reference. Thank you. I'd be happy to answer any questions.

25 JUDGE GRIMES: No more questions. Thank you.

26 MR. CALLAHANN: Thank you.

1 (Whereupon, the proceedings concluded.)

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